

**REMARKS**

By this Amendment, Applicants add new claims 39-41. Claims 30-36 and 39-41 are therefore pending in this Application.

In the final Office Action of July 26, 2005 (“Office Action”)<sup>1</sup> claims 30-36 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,539,360 (“*Kadaba*”). Applicants address this rejection, as well as the new claims, below.

**Section 102(e) rejection of claims 30-36**

Applicants traverse the rejection of claims 30-36 under 35 U.S.C. § 102(e) because *Kadaba* fails to anticipate those claims. In order to properly anticipate Applicants’ claimed invention under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim at issue, either expressly or under principles of inherency. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *See* M.P.E.P. § 2131. Also, “[t]he elements must be arranged as required by the claim.” *Id.* In this case, *Kadaba* fails to anticipate claims 30-36 because the reference fails to teach each and every element of the claims, as discussed below.

With regard to independent claim 30, *Kadaba* fails to teach at least “inputting information at a user terminal to retrieve package routing information, wherein said inputted information contains package identification, including at least a package source address, required by said at least one alias server to retrieve said package routing information.” *Kadaba* is directed to “processing packages designated for special handling and notifying an appropriate party as to whether special handling has been applied” (Abstract). In *Kadaba*’s system, a carrier’s central

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

computer system 15 “receives PLD [package level detail] information via e-mail from the consignor [i.e., the customer sending the package] computer 17.” Col. 7, lines 22-30; Fig. 3, step 100. This PLD data is then “consolidated and sorted into region-specific files,” which are referred to as “pre-alert files.” Col. 7, lines 33-37; Fig. 3, step 103. These files are uploaded to the carrier’s intranet 54, which may be accessed by various carrier terminals (56, 57, 58). Col. 7, lines 37-40, 52-54; Fig. 3, steps 104, 105. The pre-alert files may also be accessed by the consignor via a customer terminal 60 to “determine whether the special handling has been applied.” Col. 7, lines 62-67; col. 8, lines 5-10.

The Examiner alleged that *Kadaba*’s PLD information constitutes the claimed “inputted information” and that *Kadaba*’s “pre-alert files” constitute the claimed “package routing information.” *See* Office Action at 3. Even if these allegations in the Office Action were valid, *Kadaba* does not disclose inputting the PLD information “to retrieve” the pre-alert files or that the PLD information is “required by said at least one alias server to retrieve” the files, as recited in claim 30. Instead, the reference merely discloses that the consignor inputs the information “for packages being shipped on that day” and that the information is consolidated into pre-alert files. Col. 7, lines 25-37. Although *Kadaba* discloses that the carrier terminals and the consignor can access pre-alert files via the carrier intranet, the reference does not disclose that that the PLD information is required by either the carrier computer or the customer terminal to retrieve the files. *Kadaba*’s carrier computer 15 does not retrieve pre-alert files; rather, it consolidates information into the files. Further, *Kadaba* does not disclose that the customer terminal 60 requires the PLD information to retrieve pre-alert files. Indeed, neither the cited portions nor any other portions of *Kadaba* teach the “inputting” feature of claim 30.

*Kadaba* further fails to disclose at least “transferring package routing information from said alias server to said user terminal, provided said alias server locates a database record corresponding to said inputted information,” as recited in claim 30. The Examiner alleged that *Kadaba*’s disclosure regarding uploading pre-alert files to the carrier’s intranet constitutes “transferring package routing information from said alias server to said user terminal” and that the “database record” locating feature is inherent. *See* Office Action at 3 (citing *Kadaba* at col. 7, lines 37-40, col. 8, lines 54-65). The Office Action has not established that *Kadaba* expressly or inherently describes the “transferring” feature of claim 30 for at least the following reasons.

Neither the cited portions, nor any other portions, of *Kadaba* disclose the “transferring” feature of claim 30. The cited portions of *Kadaba* (col. 7, lines 37-40; col. 8, lines 54-65) merely describe uploading pre-alert files to the carrier intranet and updating the status of packages. *See* Office Action at 3. Furthermore, the Office Action has not established inherency.

As M.P.E.P. § 2112 makes clear:

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ (internal citations omitted).

In addition, M.P.E.P. § 2112 states:

[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (internal citations omitted).

In this case, the Office Action fails to provide sufficient evidence from *Kadaba*, or any recourse to extrinsic evidence, that makes clear that this feature is necessarily present in the reference. The Office Action also fails to present sufficient factual basis and technical reasoning

to demonstrate inherency. The cited portions of *Kadaba* (col. 7, lines 37-40; col. 8, lines 54-65) do not evidence that “transferring package routing information from said alias server to said user terminal, *provided said alias server locates a database record corresponding to said inputted information*” is necessarily present in *Kadaba* (emphasis added). As explained above, the cited portions of *Kadaba* merely describe uploading pre-alert files to the carrier intranet and updating the status of packages. In addition, the Office Action provides no factual basis or technical reasoning to support the notion that *Kadaba*’s carrier server would upload the pre-alert files to the intranet provided it located a database record corresponding to the PLD information (which the Examiner contends is equivalent to the claimed inputted information). Consequently, the Examiner cannot properly infer that the subject matter of claim 30 is inherently disclosed by *Kadaba*.

Because *Kadaba* does not disclose each and every element of claim 30, as a matter of law, it cannot anticipate that claim. As such, the rejection of claim 30 under 35 U.S.C. §102(e) based on *Kadaba* should be withdrawn. The § 102(e) rejection of claims 31 and 32 should be withdrawn as well, at least because those claims depend upon claim 30 and are thus similarly distinguishable from *Kadaba*.

Independent claims 33 and 36, although of different scope than claim 30 (and each other), include features similar to those of claim 30 noted above. The § 102(e) rejection of claims 33 and 36 should be withdrawn for at least reasons similar to those presented above in connection with claim 30. The § 102(e) rejection of claims 34 and 35 should also be withdrawn, at least because those claims depend upon claim 33 and are thus similarly distinguishable from the cited art. Accordingly, Applicants request withdrawal of the § 102(e) rejection and the timely allowance of claims 30-36.

**New claims 39-41**

New claims 39, 40, and 41 depend upon claims 30, 33, and 36, respectively, and are therefore similarly distinguishable from the applied art. Applicants further submit that the applied art fails to teach or suggest the additional subject matter recited in new claims 39-41. Applicants therefore request the timely allowance of new claims 39-41.

**Conclusion**

Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of pending claims 30-36 and 39-41.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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